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Datasheet for the decision of 6 November 2013

Case Number: T 0727/09 - 3.5.04

Application Number: 98934050.0

Publication Number: 993655

IPC: G06T1/00, G06T7/00, A01J5/017

Language of the proceedings: EN

Title of invention:
AN ANIMAL RELATED APPARATUS

Patent Proprietor:
DeLaval Holding AB

Opponent:
Octrooibureau Van der Lely N.V.

Headword:

Relevant legal provisions:
EPC Art. 108 sentence 3, 110, 114(2), 99(2), 101(1)
EPC 1973 Art. 99(1)
RPBA Art. 12(2)
EPC 1973 R. 55(c)
EPC R. 76(2)(c)

Keyword:
Admissibility of appeal - appeal sufficiently substantiated (no)

Decisions cited:
G 0009/91, G 0010/91, G 0004/93, G 0001/99, J 0902/87, T 0220/83, T 0213/85, T 0145/88, T 0169/89, T 0045/92, T 0389/95, T 0922/05, T 0570/07

Catchword:
Appeal based entirely on new documents without establishing a direct and clear link with the reasons of the decision it is contesting (see section 6, points 7.5 and 7.8 of the Reasons).

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Case Number: T 0727/09 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 6 November 2013

Appellant: (Opponent)	Octrooibureau Van der Lely N.V. Weverskade 110 3147 PA MAASSLUIS (NL)
Representative:	Seerden, Adrianus Maria Octrooibureau Van der Lely N.V. Weverskade 110 3147 PA Maassluis (NL)
Respondent: (Patent Proprietor)	DeLaval Holding AB P.O. Box 39 147 21 Tumba (SE)
Representative:	Zacco Denmark A/S Hans Bekkevolds Allé 7 2900 Hellerup (DK)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 19 February 2009 rejecting the opposition filed against European patent No. 993655 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman: F. Edlinger
Members: A. Dumont
C. Vallet

Summary of Facts and Submissions

I. The appeal is against the decision dated 19 February 2009 by which the Opposition Division rejected the opposition filed on 16 March 2005 against European patent No. 0 993 655. The title reads "An animal related apparatus".

II. The opponent (the appellant) filed an appeal on 31 March 2009 and paid the related fee. In the statement of grounds of appeal filed on 1 July 2009, the appellant requested that the decision be set aside and submitted ten new patent documents D7 to D16 as well as four non-patent documents X1 to X4 to support its view that the patent in suit lacked inventive step, which was the sole ground of opposition. The appellant further cited documents D1 to D6, which were considered during the opposition proceedings, noted that it maintained all facts and arguments presented in the opposition proceedings and enclosed a copy of the notice of opposition dated 16 March 2005. It also requested oral proceedings as an auxiliary measure.

III. In the rejoinder dated 18 November 2009, the respondent (the patent proprietor) requested that the appeal be rejected as inadmissible. In the event that the appeal were deemed to be admissible, it requested the board to remit the case to the first instance and to order an apportionment of the costs of the proceedings. In the event that any of the newly filed documents were admitted and considered by the board, it requested maintenance of the patent as granted and an apportionment of costs so that the additional costs incurred by the newly filed documents be borne by the appellant. If the board did not envisage to maintain the patent as granted, the respondent requested

maintenance of the patent on the basis of the claims of one of auxiliary requests 1 to 3 filed with the rejoinder and an appropriate award of costs. It also requested oral proceedings.

IV. On 29 July 2013 the board summoned the parties to oral proceedings and issued a communication in which it expressed its preliminary opinion that the appeal should be held inadmissible. The board also indicated that, should the appeal be found admissible, the admission of newly filed documents D7 to D16 and X1 to X4 into the proceedings was to be discussed on the basis of Article 114(2) EPC 1973 and Article 12(4) RPBA, with two possible outcomes: either remittal of the case to the opposition division for further prosecution and possibly an apportionment of costs in accordance with Article 104(1) EPC 1973, or a lack of evidential basis for the appeal grounds if the new documents were not admitted.

V. By letter dated 27 September 2013 the respondent further developed its argumentation as to the inadmissibility of the present appeal. This argumentation can be summarised as follows:

- the appeal was based only on a fresh set of evidence and new arguments, but provided no reasons why the contested decision was invalid, which was in accordance neither with Article 108 EPC, Rule 99(2) EPC and Article 12(2)RPBA nor with the requirements of decisions G 9/91 or G 10/91, nor with decision T 1007/95 (point 5 of the reasons), even though other decisions (for example T 389/95) adopted a more lenient approach to admissibility,

- in decision T 922/05, the competent board had underlined that a lenient approach on the issue of admissibility necessarily entailed an injustice to the other side and was therefore to be avoided, which is the case at present where the patent proprietor is presented on appeal with an entirely new opposition four years after the expiry of the opposition period,
- the reference to the grounds of the notice of opposition and to the documents filed at that time, without any comment, did not allow the board and the respondent to ascertain what aspects of the reasoning of the appealed decision the appellant regarded as incorrect, so that they were left to make their own investigations.

The respondent further developed its argumentation that the late-filed documents should be considered inadmissible pursuant to Article 114(2) EPC because they did not guarantee convergence of the debate, e.g. by a "manifestly unanswerable challenge to the validity of the opposed patent necessarily resulting in restriction or revocation of the patent", as ruled in decision T 389/95.

The respondent further maintained its further requests as to remittal to the first instance and apportionment of costs.

VI. By a letter dated 4 October 2013, the appellant pointed out that the rejoinder to the grounds for appeal had been filed after the time limit set by the board, so that the auxiliary requests introduced by the respondent could only be admitted on the board's discretion. The appellant submitted that the appeal was to be considered as admissible. It was true that most,

if not all, of the seven pages of reasoning were based on new documents. This was allowed if new facts were crucial to the maintenance of the patent (J 902/87). It held that the newly filed documents, at least D7, D8, D9 and D10, were admissible because they were highly relevant for inventive step and even novelty of the claims and because they had been filed at the earliest opportunity, more than four years ago.

As an auxiliary measure, the appellant requested remittal of the case to the first instance, subsidiarily accepting a corresponding apportionment of costs.

VII. Oral proceedings were held on 6 November 2013.

VIII. The appellant requested that the decision under appeal be set aside and that European patent No. 0 993 655 be revoked. The appellant confirmed the requests filed in the letters dated 1 July 2009 and 4 October 2013. In particular, the board should admit at least documents D7 and D10 into the appeal proceedings and examine the appeal or, in the alternative, remit the case to the first instance. The respondent's requests should not be admitted because they had been filed after the time limit set by the board for the respondent's reply to the statement of grounds of appeal.

IX. The respondent requested that the appeal be rejected as inadmissible. It further confirmed the requests submitted in its letters dated 18 November 2009 and 27 September 2013, in particular an apportionment of costs in the event that any of the documents filed on appeal were admitted for examination by the board.

Reasons for the Decision

1. The admissibility of an appeal has to be examined *ex officio* by the board, so that there is no need to consider whether or not the respondent's request to that effect is to be admitted in the proceedings.

2. The appeal complies with Article 106 EPC and Article 107 EPC 1973 as well as with the first and second sentences of Article 108 EPC. Its admissibility therefore depends solely on whether the document headed "Grounds of appeal" received on 1 July 2009 contains a "statement setting out the grounds of appeal" within the meaning of Article 108, third sentence, EPC.

3. From the literal meaning of the words of that sentence and of Rule 99(2) EPC it is clear that, in order to satisfy the criterion for admissibility, the grounds of appeal must state why, in the appellant's view, the contested decision cannot be correct, i.e. specify the legal and factual reasons why the decision should be set aside.

4. Rule 101(1) EPC provides that "If the appeal does not comply with Articles 106 to 108, Rule 97 or Rule 99, paragraph 1(b) or (c) or paragraph 2, the Board of Appeal shall reject it as inadmissible."

5. As to the content of the statement of grounds, Article 12(2) RPBA requires that "The statement of grounds of appeal and the reply shall contain a party's complete case. They shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld and should specify expressly all the facts, arguments and evidence relied on."

6. The case law of the Boards of Appeal has consistently considered it to be incumbent on an appellant, in order to meet the admissibility requirements, to explain in detail why it considers the decision under appeal to be wrong, be it entirely or in part, thus imposing a direct and clear link between the contested decision and the grounds for appeal.

6.1 In decisions G 9/91 (OJ EPO 1993, 408) and G 10/91 (OJ EPO 1993, 420), point 18 of the Reasons, the Enlarged Board of Appeal held that "The purpose of the appeal procedure *inter partes* is mainly to give the losing party the possibility of challenging the decision of the Opposition Division on its merits."

That purpose was recalled in decisions G 4/93 (OJ EPO 1994, 875, point 5 of the Reasons) and G 1/99 (OJ EPO 2001, 381, point 6.1 of the Reasons).

It is thus clear that appeal proceedings **aim at challenging a decision.**

6.2 In decision G 1/99 (points 6.1 and 6.4 of the Reasons), the Enlarged Board of Appeal further pointed out that "... issues outside the subject-matter of the decision under appeal are not part of the appeal" and that "... within the limits of what in the subject-matter of the decision under appeal adversely affects it, it is the appellant who in the notice of appeal determines the extent to which amendment or cancellation of the decision under appeal is requested."

6.3 It follows from this that opposition appeal proceedings are confined to what was the subject-matter of the first-instance proceedings and therefore that the

statement of grounds of appeal should at least discuss this subject-matter. The need for the above-mentioned link is thus not only confirmed but also clarified in that the statement of grounds has to address the reasons for the decision under appeal and not only the result.

6.4 The case law (see Case Law of the Boards of Appeal of the European Patent Office, 7th edition 2013, IV.E. 2.6.3) has developed further requirements for a statement of grounds of appeal to be admissible, namely that it must specify the legal or factual reasons as to why the impugned decision should be set aside. The arguments must be clearly and concisely presented to enable the board and the other party to understand immediately why the decision is alleged to be incorrect, and on which facts the appellant bases its arguments, without first having to make investigations of their own (see in particular decisions T 220/83 (OJ EPO 1986, 249) and T 145/88 (OJ EPO 1991, 251)).

6.5 Moreover, it is also established case law that grounds sufficient for the admissibility of an appeal must be analysed in detail vis-à-vis the main reasons given for the contested decision (see T 213/85, OJ EPO 1987, 482; T 169/89; T 45/92 and T 570/07).

7. In the present case, the statement of grounds of appeal submitted by the appellant sets out a reasoned argumentation as to why the patent should be revoked for lack of inventive step based exclusively on the newly filed documents.

7.1 However, these submissions do not contain any reference to the reasons for the impugned decision, let alone any explanation as to why this decision is incorrect and

thus to be set aside. The board and the respondent are thus facing an entirely new set of facts, albeit based on the same legal ground for opposition. Moreover, the appellant acknowledged that the appeal was effectively based on new documents only, and thus on the assumption that the decision of the opposition division was correct in its finding, which means that the arguments and the documents filed with the notice of opposition were not relevant enough to justify the revocation of the patent in suit. In other words, the aim of the present appeal is not to challenge that decision, but to file a second opposition against said patent, the first one having fallen through.

7.2 The board considers that the EPC does not allow such a broad interpretation of the aim of an appeal following opposition proceedings.

Article 99(1) EPC 1973 and Rule 55(c) EPC 1973 (now Rule 76(2)(c) EPC) provide that the opposition must be filed within nine months after the publication of the patent and that the notice of opposition shall contain "a statement of the extent to which the European patent is opposed and of the grounds on which the opposition is based as well as an indication of the facts, evidence and arguments presented in support of these grounds." If these conditions are not fulfilled within the time limit, the opposition is to be rejected as inadmissible under Rule 56(1) EPC 1973 (Rule 77(1) EPC).

As ruled in decision G 9/91 (see points 4 to 6 of the Reasons), Rule 55(c) EPC 1973 (Rule 76(2)(c) EPC) does not only imply a formal requirement for admissibility. "This provision must be considered in the context of the EPC as a whole... Rule 55(c) only makes sense

interpreted as having the double function of governing (together with other provisions) the admissibility of the opposition and of establishing at the same time **the legal and factual framework, within which the substantive examination of the opposition in principle shall be conducted**. The latter function is of particular importance in that it gives the patentee a fair chance to consider his position at an early stage of the proceedings"(emphasis added by present board).

From this statement, it follows that, in the absence of special reasons, the opponent cannot be given the opportunity to change its case at a later stage in the opposition without impairing the fairness of the proceedings to the detriment of the other party. This would *a fortiori* be the case at the appeal stage.

7.3 Moreover, the requirements for filing an admissible appeal being substantially the same as the requirements for filing an opposition, the same interpretation should apply. Rule 99(2) EPC requires the appellant to file a statement of grounds of appeal indicating the reasons for setting aside the decision impugned, or the extent to which it is to be amended, and the facts and evidence on which the appeal is based; this means, by the same token, that this statement is not a simple formal request for a general re-examination of the case by a second-instance body but a reasoned statement in the framework of what was the legal and factual subject-matter of the decision impugned (see G 9/91, point 4 of the Reasons).

7.4 In the case at issue, the legal framework remains the same in that the reasoning is based on the same ground for opposition, namely lack of inventive step, but the factual basis is entirely new. However, both conditions

must be understood as cumulative, otherwise Rule 55(c) EPC 1973 (Rule 76(2)(c) EPC) would be purposeless and the principle of fairness of the proceedings would be impaired.

7.5 This does not mean that the appellant/opponent is not allowed to support its grounds for appeal with new evidence and with new arguments and that the filing of such a statement would in any case be contrary to the provisions of Rule 99(2) EPC. But, if the statement of grounds of appeal is exclusively based on these new documents, there must be a direct and clear link between the contested decision and the grounds for appeal, as explained above in points 6 and 6.3. For instance, such a statement of grounds must serve the purpose of strengthening the reasoning previously developed at the first-instance stage so as to render it more convincing in order to overcome the reasons for the adverse decision.

7.6 The present board is aware that this criterion of a statement of grounds able to overcome the reasons for the adverse decision, such as objections raised in the decision at issue, has been used in a significant body of case law where the statements of grounds were regarded as sufficiently reasoned as to render the appeals admissible in so-called "fresh cases" (see Case Law of the Boards of Appeal of the European Patent Office, 7th edition 2013, IV.E.2.6.5). Nevertheless, for the reasons given above, a direct and clear link with the impugned decision must be maintained, which is not the case here.

7.7 The appellant argued that this link existed due to the fact that it expressly upheld all facts and arguments presented in the opposition proceedings and that it

also referred in the statement of grounds to previously filed documents D1 to D6. However, in the absence of any reasoning as to these facts, arguments and documents, the respondent and the board are left having to guess what the position of the appellant is as to the merits of the decision impugned. This is exactly what the requirement of a statement of grounds is designed to avoid. It is not part of the board's duty to make investigations of its own; that would be contrary to the neutrality required for the board in opposition appeal proceedings. Moreover, as also stated in decision T 922/05, point 19 of the Reasons, undue leniency would be detrimental to the interest of the respondent.

7.8 The appellant also argued (referring to J 902/87) that it was allowed to introduce new documents if this was crucial to the maintenance of the patent. The board agrees that this may be allowed. The present appeal is not to be held inadmissible due to the filing of new documents. Such a conclusion would be erroneously based on confusion between admissibility and allowability. The board agrees that, as stated in decision T 389/95 (see point 1 of the Reasons), the admissibility of an appeal should be determined by objective criteria and should not depend on the way the board exercised its discretion under Article 114(2) EPC as to the admission of new documents into the proceedings, be it at the respondent's prompting or not. **The objective criterion, as the present board sees it, is that an appeal based only on new documents is not admissible if the appellant fails in its statement of grounds to establish a direct and clear link with the reasons of the decision it is contesting**. The relevance of the newly-filed evidence is completely outside the scope of the sole issue under scrutiny at the admissibility

stage. The choice made by the appellant to break the link between the decision impugned and the factual framework proposed on appeal results in a new case which is disconnected from the subject-matter of the first-instance proceedings. Such a missing link can be clearly and objectively assessed, so that parties are given a fair and predictable indication of what is an admissible appeal.

7.9 The present board also fully agrees with the reasons given in point 2 of the Reasons in the above-cited decision T 389/95, in particular points 2.2, 2.8 and 2.9. These reasons relate the admissibility of new documents on appeal within the same legal framework to the admissibility of a new legal ground on appeal (which is not admissible): the decision to reject the newly-filed documents is based not on the content of these documents but essentially on a general reasoning that could apply to each and every "fresh case". The present board endorses these considerations but is of the opinion that, if an appellant’s case in the statement of grounds of appeal is exclusively based on new documents and does not establish a direct and clear link with the reasons in the contested decision, as in the present case, then these considerations play a role for the appeal's admissibility because this relates to issues outside the subject-matter of the decision under appeal. Any further analysis, such as the probative value of the new documents, is part of the assessment of the allowability of a request, which, as stated by Article 110 EPC, follows that of its admissibility.

7.10 Consequently, the appeal has to be rejected as inadmissible.

8. The request for apportionment of costs filed by the respondent does not apply, since no new document has been admitted into the proceedings. Therefore there is no need to decide either on its admissibility or on its allowability.

Order

For these reasons it is decided that:

The appeal is rejected as inadmissible.

The Registrar: The Chairman:

L. Fernández Gómez F. Edlinger

Decision electronically authenticated